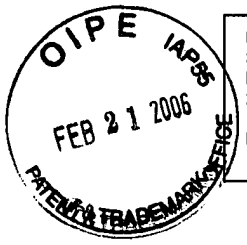
IFW



I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 2/16/06 Signature: _____ (Susan Lanney)

Docket No.: SOHN-P01-001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	Warren Stern	Confirmation No.:	8880
Application No.:	10/687,470	Art Unit:	1616
Filed:	October 16, 2003		
For:	METHOD OF TREATING SNORING AND OTHER OBSTRUCTIVE BREATHING DISORDERS	Examiner:	STITZEL, D. P.

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This response is filed in reply to the outstanding Restriction Requirement, mailed December 27, 2005, in connection with the above application. The period for response has been extended to February 27, 2006, by the accompanying petition for one month extension. Applicant hereby elects Group I, Claims 1 and 5-11, *with traverse*, on the following grounds.

Applicant traverses this restriction requirement on the basis that Groups I – IV, especially Groups I and II, are so closely related, such that simultaneous search of these groups can be made without imposing additional serious burden on the Examiner.

Pursuant to MPEP 803, "[t]here are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent ... or distinct as claimed ...; and (B) There must be a serious burden on the examiner if restriction is required...If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

In the instant case, Groups I – III, especially Groups I and II have many overlapping claims. In fact, the only non-overlapping Groups I and II claims are the independent claims. Thus it does not appear that there would be undue search burden when these claims are examined simultaneously. Accordingly, reconsideration and withdrawal of the Restriction Requirement is respectfully requested.

The Restriction Requirement indicates that Claims 5 and 6 are "generic to a plurality of disclosed patentably distinct species ...," and requires Applicant to elect a single disclosed species, and a single disclosed subspecies for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable.

Applicant hereby elects *with traverse*, and *for search purpose only*, species "an inhibitor of H^+, K^+ ATPase," and subspecies "PREVACID® (lansoprazole)," which structural formula is represented by Formula (IX). Applicant submits that the species "an inhibitor of H^+, K^+ ATPase" appears to be inadvertently omitted by the Examiner in the list of species in paragraph "2" of the Restriction Requirement on page 7.

Currently, Group I Claims 1, 5, 6, 8, 9, and 11 read on the elected species and subspecies.

Applicant traverse the species and subspecies election, because the species and subspecies subjected to election are encompassed by Markush groups. Pursuant to MPEP 803.02, "If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions." Applicants submit that such is the case in the instant application. Particularly, since all species and subspecies are compounds used for treating symptoms of hyper-acidity or gastro-intestinal reflux disease (GERD), claims directed to all species and subspecies can be simultaneously examined without significant additional burden on the Examiner, by, for example, conducting a term search for "GERD" etc. In addition, Applicant respectfully points out that the search of the Markush-type claim will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02).

In addition, Applicant notes that Claims 1, 5, and 6 are generic claims linking elected and non-elected species and subspecies. Pursuant to MPEP 809.04, "[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim." Thus, restrictions imposed on species / subspecies encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicant is entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141 (MPEP 809.02(a)).

Furthermore, the burden is on the Examiner to examine these generic claims throughout their scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicant to limit the scope of the generic claims to conform to the scope of any species or inventions listed in a Restriction Requirement.

CONCLUSION

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. The Director is hereby authorized to charge any other deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. **18-1945**, under Order No. **SOHN-P01-001**.

Dated: February 16, 2006

Respectfully submitted,

By_____

Yu Lu, Ph.D.
Registration No.: 50,306
Fish & Neave IP Group
ROPES & GRAY LLP
One International Place
Boston, Massachusetts 02110-2624
(617) 951-7000
(617) 951-7050 (Fax)
Attorneys/Agents For Applicant